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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/709,322	04/28/2004	Gary L. Rytlewski	22.1391CON	3321

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EXAMINER	
STEPHENSON, DANIEL P	

ART UNIT	PAPER NUMBER
3672	

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/709,322	RYTLEWSKI ET AL.	
	Examiner	Art Unit	
	Daniel P Stephenson	3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 June 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-32* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23 and 25-32* is/are rejected.

7)☒ Claim(s) *24* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *06 July 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 13-25, 28 and 29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4, 8-10 and 16-25 of U.S. Patent No. 6,763,889. Although the conflicting claims are not identical, they are not patentably distinct from each other because they merely remove limitations of the prior patent and broaden the scope of the claim. Since the claims use the term comprising within the claim language it is an obvious variant of the claims to remove limitations.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this

> subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 13, 14, 28 and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by the pre-grant publication '552 to Moss. Moss (Figures 2 and 3, para. 11-29) discloses an apparatus for use with a subsea well. The apparatus has a carrier line spool which has a carrier line that is adapted to be positioned underwater and to be operatively coupled to subsea wellhead equipment. The carrier line spool is a coiled tubing or wireline spool. There is an injector head adapted to drive coiled tubing from the coiled tubing spool, the injector head located on a stack on the wellhead, along with the coiled tubing spool. The apparatus also has a carousel containing a plurality of intervention tools. The carousel is rotatable underwater to enable switching of tools for connection to the carrier line. An underwater marine unit is adapted to operatively couple the carrier line to the subsea wellhead equipment, namely an ROV. The ROV takes down an umbilical line to the stack to receive command signals.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moss '552. Moss '552 shows all the limitations of the claimed invention, except, it does not disclose that the ROV is controlled through wireless acoustic wave signals. It is Officially Noticed that it is notoriously conventional in the subsea art to control a ROV through an assortment of technologies, including acoustic wireless signaling, umbilical with digital/electronic signaling,

wireless digital signal, fiber optics, etc. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to control the ROV of Moss '552 through the use of wireless acoustic signals. This would be done to allow for more flexibility in the movement of the ROV.

7. Claims 1-3, 5, 6, 9, 10, 17, 18, 20-23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moss '552. Moss '552 shows all the limitations of the claimed invention, except, it does not disclose that the stack is separate from the carrier spool. It would have been obvious to one of ordinary skill in the art at the time the invention was made to separate the sections of the stack carrying the spool and the injector, since it has been held that constructing a formally integral structure in various elements, i.e. two stacked boxes instead of one frame, involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

8. Claims 4, 7, 19 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moss '552 as applied to claims 1, 6, 17 and 18 above, and further in view of Avakov et al. Moss '552 shows all the limitations of the claimed invention, except, it does not disclose that the carrier spool is placed on the sea floor or that there is a gooseneck that attaches the line to the injector of the stack. Avakov et al. discloses, as is common with many wellhead arrangements, that the carrier spool is located on the floor near the stack. The line moves through a gooseneck within the stack above the wellhead when it is injected. It would have been obvious to one of ordinary skill in the art at the time the invention was made to place the spool of Moss '552 on the floor and inject the line through a gooseneck as taught by Avakov et al. This would be done so that there was less weight on the wellhead and/or stack.

9. Claims 8 and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moss '552 in view of Kogure et al. Moss '552 shows all the limitations of the claimed invention, except, it does not disclose that there are buoyancy tanks located on the stack or carrier spool. Kogure et al. teaches the usefulness of buoyancy tanks when dealing with subsea vessels (col. 4 lines 31-51). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made for the apparatus of Moss '552 to use the buoyancy devices as claimed by Kogure et al. This would allow greater control over the apparatus and allow them to come to the surface when necessary.

10. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moss '552 in view of Avakov et al. as applied to claim 26 above, and further in view of Kogure et al. Moss '552 in view of Avakov et al. shows all the limitations of the claimed invention, except, it does not disclose that there are buoyancy tanks located on the stack or carrier spool. Kogure et al. teaches the usefulness of buoyancy tanks when dealing with subsea vessels (col. 4 lines 31-51). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made for the apparatus of Moss '552 in view of Avakov et al. to use the buoyancy devices as claimed by Kogure et al. This would allow greater control over the apparatus and allow them to come to the surface when necessary.

11. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moss '552 as applied to claim 1 above, and further in view of Reynolds. Moss '552 shows all the limitations of the claimed invention, except, it does not disclose that there is an emergency disconnect package in the stack nor does it state that there is a connector between the emergency disconnect and the wellhead. Reynolds discloses an emergency disconnect (45) for use with a

subsea well. Naturally, since the emergency disconnect is attached to the wellhead, then there is a connector between the disconnect and the wellhead. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use an emergency disconnect on the apparatus of Moss '552. This would be done to prevent any catastrophes should the stack break away from the wellhead do to undersea current.

Response to Arguments

12. It is the assertion of the applicant that the ROV of Moss '552 does not anticipate the terms "underwater marine unit adapted to operatively couple a carrier line to subsea wellhead equipment". The examiner respectfully traverses this assertion. It is the opinion of the examiner that if the stack of Moss '552 is attached to the wellhead by the ROV then that alone is enough to state that the ROV is coupling the carrier line with the wellhead equipment.

13. It is the assertion of the applicant that Moss would not be combined with Kogure et al. due to the nature of the patents. Moss is directed to the elimination of a riser from an underwater installation while Kogure et al. is directed to a riser and riser stabilization system. While this would be true if I were using the primary function of the Kogure et al. patent in combination with Moss, it is not when just using the buoyancy tanks as disclosed in Kogure et al. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, The

specification of Kogure et al. clearly states (Col. 4 lines 31-36) that if more control is required subsea, then the use of buoyancy tanks on the riser would be preferred. While this is teaching the use of the tanks with a riser, the theory is sound for any other subsea implement.

Allowable Subject Matter

14. Claim 24 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The pre-grant publication '618 to Schempf et al., Gist et al., Hughes, Fontana et al and the pre-grant publication '714 to Smith et al. all show similar elements to those of the present invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel P Stephenson whose telephone number is (703) 605-4969. The examiner can normally be reached on 8:30 - 5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on (703) 308-2151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Bagnell
Supervisory Patent Examiner
Art Unit 3672

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